

REMARKS:Claims 1, 3, 4, 7, 9-13, 16, 18-22, 25, 27, 38 and 39

Claims 1, 3, 4, 9, 10-13, 18-22, 27, 38 and 40 have been rejected under 35 USC 103(a) as being anticipated by Firepad FireViewer Suite User's Guide (Firepad) in view of "Palm Programming" by Glenn Bachmann (Bachmann).

The analysis of obviousness was set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference or combined references must teach or suggest *all the claim limitations*. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; emphasis added).

Applicants respectfully believe that the rejection based on Firepad and Bachmann is improper as failing the *Graham* test. Specifically, the modification of Firepad based on Bachmann as proposed in the rejection fails at least the first and third elements of the *Graham* test.

Claim 1 requires allowing organization of the content, allowing formatting of the content, and outputting a preview that shows how the organized and formatted content will appear on the display screen of the wireless device relative to each other.

Regarding the third element of the *Graham* test, that of teaching or suggesting all claim limitations, Applicants do not believe that Firepad fairly teaches or suggests the step of allowing organization of the content. The rejection indicates that this feature is "performed automatically by the FireViewer of pp. 21-23 that allows selection and

viewing of content by content type.” However, the rejection is erroneous on several points.

First, what is disclosed in Firepad at pp. 21-23 is not really *allowing* organization of the content. Rather, it appears that icons for the various content items (image, hypertext document, video) appear to the left on the Main View. In the images example, images are indicated by a flame icon to the left on the Main View. The user can select an image by tapping and releasing the image name from the Main View. See Firepad p. 21. In the hypertext documents example, documents are indicated by a document icon to the left on the Main View. The user can select a document by tapping and releasing the document name from the Main View. See Firepad p. 22. In the videos example, videos are indicated by a document icon to the left on the Main View. The user can select a video by tapping and releasing the video name from the Main View. See Firepad p. 23. Thus, the icons are present on the Main View, but Applicants have been unable to find any indication that Firepad allows anyone or anything to organize the icons, much less the content. Rather, it appears that the icons are merely present to the left of the Main View in no particular order, and there is certainly no disclosure or suggestion that the content represented by the icons are organized in a manner where someone or something has been *allowed* to organize them.

Second, the rejection appears to insinuate that because a user can view content by content type, then FireViewer must somehow organize the content by content type. Again, as mentioned above, the content is represented by icons on the left of the Main View. No organization of the content is suggested. The type of content is indicated by the type of icon. However, the mere fact that a user can open a document by selecting a document icon does not mean that the content is organized in any particular manner.

Third, assuming arguendo that FireViewer does in fact *automatically* organize the content as stated in the rejection, then it cannot be said that FireViewer *allows* organization of the content as required by the claim. Rather, by automatically organizing the content, FireViewer in actuality would not allow organization of the content, it would simply do it.

Fourth, the section of Firepad cited in the rejection to anticipate the requirement of allowing organization of content discusses FireViewer, which is resident on the device, not on a management screen as claimed.

Fifth, nowhere does Firepad or Bachmann teach or suggest that once someone or something is *allowed* to organize the content, the content *as organized* is shown on a preview of a display screen of the device.

Finally, even if Bachmann's preview capabilities were added to Firepad, the combination would still not meet the claims, because FireViewer is unable to depict organized and formatted textual and graphical content simultaneously on one screen. Thus, for this reason also, the rejection of claim 1 fails the third element of the *Graham* test.

For any of the foregoing reasons, FireViewer and Bachman fail to teach or suggest each and every limitation of claim 1 in violation of the *Graham* test. Reconsideration and allowance of claim 1 is respectfully requested.

Regarding the first element of the *Graham* test, that of suggestion or motivation, Applicants respectfully disagree that one skilled in the art would have been motivated to modify Firepad with Bachman. Particularly, FireViewer only allows viewing one document, image or video at a time. As noted above, the list of available content is presented on the Main View of FireViewer, and the user merely selects one of the icons from the list to view that one piece of content. Thus, a user can only view an image, a document, or a video, but not, say, an image and a document simultaneously.

Accordingly, because the user can only view one content item at a time in FireViewer, there is no need for FireConverter to show a preview of textual and graphical items together, as claimed. Accordingly, FireConverter only allows conversion of one image, one video, or one hypertext document at one time, but not two of these types together. See Firepad pp. 11-16. Thus, the preview pane of FireConverter shown on p. 12 and 14, which is the *same size* as the Palm device screen size, is sufficient to show the image being converted, the video being converted, or the URL being

converted. In other words, because a user can only view one image at a time or one video at a time on FireViewer, and FireConverter already outputs a full-Palm-screen preview of how the image or video will be shown on the device running FireViewer, there is no legitimate reason to include Bachmann's POSE screen. Addition of Bachmann's screen would be a redundancy, providing no more features than are already present in FireConverter.

For any of these reasons, the combination of art proposed in the rejection of claim 1 fails the first element of the *Graham* test. Reconsideration and allowance of claim 1 is respectfully requested.

Claims 3, 4, 7 and 9 depend from claim 1, and therefore incorporate the limitations of claim 1. By virtue of their dependence, claims 3, 4, 7 and 9 are also believed to be allowable. Reconsideration and allowance of claims 3, 4, 7 and 9 is respectfully requested. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 10 contains limitations similar to those of claim 1 and so is believed to be allowable for the same reasons as claim 1. Claims 11-13, 16 and 18 depend from claim 1, and therefore incorporate the limitations of claim 1. By virtue of their dependence, claims 11-13, 16 and 18 are also believed to be allowable. Reconsideration and allowance of claims 10-13, 16 and 18 is respectfully requested.

Claim 19 contains limitations similar to those of claim 1 and so is believed to be allowable for the same reasons as claim 1. Claims 20-22, 25 and 27 depend from claim 1, and therefore incorporate the limitations of claim 1. By virtue of their dependence, claims 20-22, 25 and 27 are also believed to be allowable. Reconsideration and allowance of claims 19-22, 25 and 27 is respectfully requested.

Claims 38 and 39 contain limitations similar to those of claim 1 and are believed to be allowable for the same reasons set forth above. Allowance of claims 38-39 is respectfully requested.

Claims 2, 28, 29, 32, 34, 35 and 40

Claims 2, 28, 29, 32, 34, 35 and 40 have been rejected under 35 USC 103(a) as being unpatentable over Firepad in view of Bachmann and in yet further view of Martin (US6610105).

Claim 2 depends from claim 1 and is therefore believed to be allowable over the combination of Firepad and Bachmann for the same reasons as claim 1. Because Martin has merely been added to show an aggregated content portal which could be added to the system of Firepad as modified by Bachmann, the impropriety of the modification of Firepad based on Bachmann remains and the rejection is improper as failing the *Graham* test.

Further, regarding claim 2, Applicants respectfully assert that the combination of art is improper as failing the *Graham* test. Particularly, the combination proposed fails to teach or suggest each and every claim limitation. As noted above, Firepad as modified by Bachmann fails to disclose or suggest outputting a preview including both textual and graphical content simultaneously. Likewise, Martin fails to teach or suggest this feature. As noted at Martin col. 8, lines 27-30 and col. 9, lines 16-30, the preview is merely a navigation metaphor (302) showing a list of links, not graphical content. See also, *inter alia*, Martin FIGs. 3A and 4D; col. 10, lines 1-7, 61-65; col. 11, lines 22-28. Accordingly, none of the references teach or suggest outputting a preview simultaneously depicting how textual and graphical content will be shown on a display screen of the wireless device, in violation of the *Graham* test. Reconsideration and allowance of claim 2 is respectfully requested.

Applicants further assert that there is insufficient suggestion or motivation to modify Firepad with Bachmann, and even further with the teachings of Martin as suggested in the rejection. Accordingly, the rejection fails the *Graham* test. Again,

Martin's preview only outputs a list of textual hyperlinks. It does not also output graphical data. Accordingly, Firepad, as modified by Bachmann and further by Martin would only display a preview of textual data at one time, not both graphical and textual data simultaneously as required by the instant claims. For this reason as well, the rejection of claim 2 is improper as failing the *Graham* test. Reconsideration and allowance of claim 2 is respectfully requested.

Claim 28 includes limitations similar to those of claim 1. Accordingly, the modification of Firepad with Bachmann is improper. Because Martin has merely been added to show an aggregated content portal, email service, wireless download, and creation of links for downloading data to a wireless device, which could purportedly be added to the system of Firepad as modified by Bachmann, the impropriety of the modification of Firepad based on Bachmann remains.

Claim 28 further requires that the user be allowed to create a link to content, where selection of the link downloads additional content from a remote data source. In contrast, Firepad only provides web archive support. See Firepad p. 15-16. As noted there, web pages are prepared for storage on the device itself and must be stored on the device prior to selection of the link. In contrast, the claimed invention does not download the content to the wireless device until the link is selected. This provides two advantages. One, downloading the content after selection of the link requires less storage on the device. Second, if the content pointed to by the link changes, the user will get the latest information as the content is then downloaded.

Firepad further fails to teach or suggest the claimed feature of allowing access to a web search service from the wireless device. Support for this limitation is found on p. 18, line 29 to p. 19, line 26.

Claims 29, 32, 34 and 35 depend from claim 28. Allowance of claims 28, 29, 32, 34 and 35 is respectfully requested.

Further, regarding claims 28, 29, 32, 34, and 35, Applicants respectfully assert that the combination of art is improper as failing the *Graham* test. Particularly, the combination proposed fails to teach or suggest each and every claim limitation. As noted above, Firepad as modified by Bachmann fails to disclose or suggest outputting a preview including both textual and graphical content simultaneously. Likewise, Martin fails to teach or suggest this feature. As noted at Martin col. 8, lines 27-30 and col. 9, lines 16-30, the preview is merely a navigation metaphor (302) showing a list of links, not graphical content. See also, *inter alia*, Martin FIGs. 3A and 4D; col. 10, lines 1-7, 61-65; col. 11, lines 22-28. Accordingly, none of the references teach or suggest outputting a preview simultaneously depicting how textual and graphical content will be shown on a display screen of the wireless device, in violation of the *Graham* test. Reconsideration and allowance of claims 28, 29, 32, 34, and 35 is respectfully requested.

Applicants further assert that there is insufficient suggestion or motivation to modify Firepad with Bachmann, and even further with the teachings of Martin as suggested in the rejection. Accordingly, the rejection fails the *Graham* test. Again, Martin's preview only outputs a list of textual hyperlinks. It does not also output graphical data. Accordingly, Firepad, as modified by Bachmann and further by Martin would only display a preview of textual data at one time, not both graphical and textual data simultaneously as required by the instant claims. For this reason as well, the rejection of claims 28, 29, 32, 34, and 35 is improper as failing the *Graham* test. Reconsideration and allowance of claims 28, 29, 32, 34, and 35 is respectfully requested.

Claim 40 contains similar limitations to claim 28, and is believed to be allowable over the proposed combination of art for the same reasons set forth above.

Claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31, 33

Claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31 and 33 have been rejected under 35 USC 103(a) as being unpatentable over Firepad in view of Shinbori (US4661000).

Claims 5, 6 and 8 depend from claim 1. As mentioned above, Firepad fails to teach or suggest each and every limitation of claim 1, *inter alia*, outputting a preview of a display screen of the wireless device, the preview including both textual and graphical content simultaneously. Likewise, Shinbori does not output both text and graphical content. As shown in Shinbori FIGS. 11(b), 12(b), 13(b) and 14(b), no text is actually displayed in Shinbori's layout display. Rather, dots are used to indicate a character and line layout on a page to be printed. See col. 9, lines 41-56. Accordingly, the combination proposed in the rejection fails the *Graham* test for failing to teach or suggest each and every limitation of claims 1, 5, 6 and 8.

Claims 14, 15 and 17 depend from claim 10, which contains limitations similar to claim 1. The rejection is improper for the same reasons presented above for claims 1, 5, 6 and 8.

Claims 23, 24 and 26 depend from claim 19, which contains limitations similar to claim 1. The rejection is improper for the same reasons presented above for claims 1, 5, 6 and 8.

Claims 30, 31, 33 depend from claim 28, which contains limitations similar to claim 1. The rejection is improper for the same reasons presented above for claims 1, 5, 6 and 8.

Further, Applicants respectfully traverse the rejection of claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31 and 33 based on Firepad and Shinbori because Shinbori is nonanalogous art. The Examiner has considered these arguments and responded in the "Response to Arguments" section of the office action. However, Applicants respectfully disagree with the Examiner's reasoning.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was

concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Taking the first element, Shinbori is not in the field of Applicants’ endeavor, managing content for output on wireless devices. Rather, Shinbori describes a layout display device of an electronic printer. See Shinbori col. 1, line 63 to col. 2, line 19. As shown in Shinbori FIGS. 11(b), 12(b), 13(b) and 14(b), no text is actually displayed in Shinbori’s layout display. Rather, “dots” are used to indicate a character and line layout of a page to be printed. See col. 9, lines 41-56. Thus, on its face, Shinbori is most definitely not in the field of managing content for output on wireless devices.

Considering the second element, Shinbori is not reasonably pertinent to the particular problem with which the inventors were concerned. Shinbori automatically formats textual content so that all of the display segments in a printer layout display are used. See Shinbori col. 1, lines 60-62. As shown in Shinbori FIGS. 11(b), 12(b), 13(b) and 14(b), no text is actually displayed in Shinbori’s layout display. Rather, dots are used to indicate a character and line layout on a page to be printed. See col. 9, lines 41-56. Therefore, because Shinbori does not pertain to display of text but rather “dots” used to show how a page will be printed, Shinbori is not relevant to the problem with which the inventors were concerned, namely that of allowing configuration of how text and graphical content are displayed simultaneously on a display screen of a wireless device.

Accordingly, Shinbori is believed to be disqualified as a prior art reference.

Allowance of claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31 and 33 is respectfully requested.

Claims 36-37

Claims 36 and 37 have been rejected under 35 USC 103(a) as being unpatentable over Firepad.

Regarding claims 36 and 37, Applicants respectfully disagree that claims 36 and 37 are obvious over Firepad. Applicants respectfully disagree with assertion that it would have been obvious to modify the teachings of Firepad to anticipate claims 36 and

37. Specifically, the modification proposed by the Examiner fails the first element of the *Graham* test.

Regarding the first prong of the *Graham* test, a statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In the instant case, the rejection merely indicates that it would have been obvious to one skilled in the art to add a navigation tree, such as that found in Microsoft Windows Explorer, to Firepad in order to meet the claimed limitations. Applicants respectfully disagree. Nowhere does Firepad itself suggest addition of a navigation tree for such things as allowing linking from one window in one view to another window in another view. Rather, the rejection relies on features purportedly “notoriously well known in the art.” Accordingly, it cannot be said that Firepad itself suggests the proposed modification or addition of features from other software such as Microsoft Windows.

Nor has the Examiner provided a reasonable motivation based on knowledge generally available to those skilled in the art and not provided by Applicants in the present disclosure.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Nowhere does the rejection provide a motivation to add such a navigation tree to Firepad. In fact, the rejection indicates that the tab method of Firepad “performs the

same functions as that of the claimed navigation tree.” If the Firepad tab method is truly equivalent to the navigation tree as suggested in the rejection, why would one skilled in the art be motivated to add the navigation tree to Firepad if they “perform equally as well”? The functionality would already be there. Thus, the only conclusion that can be drawn is that the combination of art proposed by the Examiner has been drawn from Applicants’ disclosure.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As noted in the rejection, the Firepad tab method is fully functional and “performs equally as well” as the navigation tree, so it cannot be said that Firepad suggests modification of itself to include a navigation tree.

Because the *Graham* test is not met, allowance of claims 36 and 37 is respectfully requested.

Claims 41-44

Claims 41-44 have been rejected under 35 USC 103(a) as being unpatentable over Firepad in view of Bachmann, in yet further view of Martin, and in still yet further view of Maes (US6016476).

Claims 41-42 are dependent upon claim 40. Because claim 40 is believed to be allowable over Firepad, Bachmann and Martin, and because Maes has simply been added to show use of a text-to-speech converter, the impropriety of the modification of Firepad based on Bachmann remains. Therefore, claims 41-42 are believed to be allowable over the proposed combination of references. Allowance of claims 41-42 is respectfully requested.

Claims 43-44 are dependent upon claim 1. Because claim 1 is believed to be allowable over Firepad, Bachmann and Martin, and because Maes has simply been added to show use of a text-to-speech converter, the impropriety of the modification of Firepad based on Bachmann remains. Therefore, claims 43-44 are believed to be

allowable over the proposed combination of references. Allowance of claims 43-44 is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NVIDP376/P002188).

Respectfully submitted,

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